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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,656	11/09/1999	KENJI TAGAWA	00177/530318	6961

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,656

Applicant(s)

Tagawa et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 22 (Amdt), June 2 (RCE), and July 27 (Supl Amdt), 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24, 26-28, and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26-28, and 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submissions filed on April 22, 2004 and July 27, 2004 have been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on April 22, 2004, as well as to the supplemental amendment and arguments filed by applicant on July 27, 2004, both in reply to the Office action mailed October 22, 2003.

3. This Office action replaces the previous Office action, mailed July 28, 2004, which may be disregarded entirely, this supplemental Office action being cumulative in nature, thus incorporating herein all content of the previous Office action, as well as restarting the time period for reply.

4. The amendment of claims 22, 26, and 28 by applicant on April 22, 2004 is hereby acknowledged.

5. The cancellation of claims 25 and 29-42 by applicant on April 22, 2004 is hereby acknowledged.

6. The addition of claims 43-48 by applicant on July 27, 2004 is hereby acknowledged.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 22-24, 26-28, and 43-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et al. (US 5,870,467). Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded

little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions. See MPEP §2114.

Imai et al. show a data conversion apparatus 100 comprising: a data transmission/receiving section/means 11; a data format judging section/means 3; an attribute information obtaining section/means 4; a user ID storage section/means storing identification information identifying the user of the data conversion apparatus (a user ID identifying the user of the data conversion apparatus being necessarily, thus inherently, present in order to perform the disclosed “authentication”); a ciphering section/means 132 for ciphering the attribute information (ciphering being necessarily, thus inherently, present in order to “protect” the data in the manner disclosed); a data format conversion section/means 5 for adding the ciphered attribute information and identification information to the audio contents; and, a controller 1, wherein the data transmission/receiving section/means of Imai et al. includes a data read-out portion 6 and a network interface 102. See, in particular, Figure 11.

Regarding claims 23 and 44, the data conversion apparatus of Imai et al. further comprises a data outputting section/means 6.

Regarding claims 24 and 45, the data conversion apparatus of Imai et al. further comprises a recording section/means 105 and a charging section 104.

Regarding claims 26-28 and 46-48, the recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions. See MPEP §2114.

Response to Arguments

9. Applicant's arguments filed April 22, 2004 and July 27, 2004 have been fully considered but they are not persuasive.

10. Regarding the argument that Imai et al. does not disclose all of the recited functional language recited by applicant's apparatus claims relative to the specific copyright/data protection scheme/format known as "superdistribution" (though "superdistribution" is specifically mentioned by Imai et al.) a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

11. Regarding the argument that the data transmission/receiving section of the data conversion apparatus 100 of Imai et al. fails to include a data read-out portion and a network interface, the data transmission/receiving section of Imai et al. indeed includes a data read-out portion 6 and a network interface 102. See, in particular, Figure 11.

12. Regarding the argument that the Imai et al. fail to disclose certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., performing a CDDB-type

of remote audio CD database lookup to identify a normal, non-super-distribution, audio CD) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of reading data out of a disc medium, the data conversion apparatus 100 of Imai et al. is indeed capable of reading data out of a disc medium, and, in the event that any translation issues may possibly be creating confusion, the examiner specifically notes that audio contents of a CD are considered “data in a disc medium.”

14. Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of storing identification information identifying the user of the data conversion apparatus, the data conversion apparatus 100 of Imai et al. is indeed capable of storing identification information identifying the user of the data conversion apparatus, since a user ID identifying the user of the data conversion apparatus is necessarily, thus inherently, present in order to perform the disclosed “authentication” (authentication being the determination/establishment of identity).

15. Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of recording superdistribution format data, the data conversion apparatus 100 of Imai et al. is

indeed capable of recording superdistribution format data, as that is one of its explicitly disclosed intended purposes.

16. Regarding the argument that all functional language must be considered in new claims 43-48 because the claims are written in means-plus-function format, new claims 43-48 do indeed define *structure* in means-plus-function format, but, additionally, still recite intended usage as well, and the intended usage still need not be explicitly disclosed in the reference if the claimed *structure*, as disclosed in the reference, is inherently capable of performing the claimed *usage*.

For example, the recitation, “a ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means” (claim 43, lines 18-19) includes both structure defined in means-plus-function language, “a ciphering means” (which recitation is considered equivalent to the more literal/traditional, “a means for ciphering,” as explained in MPEP §2181), as well as an intended usage of the “means for ciphering,” that being, “for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means.”

Note that, even if defined in means-plus-function format, apparatus claim limitations are still drawn to *structure*, and the structure in a reference, to be anticipatory, can *either* be the same as, *or equivalent to*, the disclosed structure of the claimed invention. See MPEP §2114, which states, in part, “that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification.”

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to the disclosure.

18. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.


Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

October 14, 2004

 (10-14-04)

Gerald J. O'Connor
Patent Examiner
Group Art Unit 3627